REMARKS

Claims 1-15 are pending in the application and are rejected. Claims 1 and 6 are herein amended. Claims 3 and 4 are herein canceled.

Claim Rejections - 35 U.S.C. §112

Claims 1-15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner notes that claim 1 recites "wherein a ratio of said glass particles to the top layer is a weight ratio of less than 3%" in the last line. The Examiner asserts that it is unclear what this limitation encompasses. Furthermore, the Examiner asserts that this limitation is indefinite because line 5 recites "glass particles are mixed into at least one of said primer layer and said top layer".

Applicant respectfully disagrees with this rejection, and asserts that the claim is clear on its face. By the claim language, the weight ratio of glass particles to the top layer is the stated ratio. The fact that the glass particles may be mixed into the primer layer instead of the top layer does not change the fact that the weight ratio of glass particles to the top layer is the stated ratio.

Claims 4 and 6 are rejected because they recite "1% or more", which unclear because of the limitation "less than 3%" in claim 1.

Applicant herein cancels claim 4 and amends claim 6 to recite "1% ~~or more~~ to less than 3%". Applicant submits that this amendment addresses the rejection.

Claim Rejections - 35 U.S.C. §102

Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Matsuyama (JP 57172374 A).

The Examiner asserts that Matsuyama teaches a specific example of about 1% of glass fibers which is within the claimed range of "less than 3%". Therefore, Matsuyama anticipates the claimed range.

Applicant disagrees with the statement that Matsuyama "teaches a specific example" of about 1% of glass fibers in the top layer. However, upon review of the translation of Matsuyama, Applicant notes note that Matsuyama recites that "wear resistance is effectively improved only by adding a small amount, or about 1% of glass fibers..."

Applicant herein amends claim 1. Subsequently, Applicant respectfully disagrees with the rejection, because not all of the claimed limitations are taught by the cited reference. Specifically, claim 1 now recites that glass particles are mixed into ~~at least one of~~ either: said primer layer, or said primer layer and said top layer. In other words, the glass particles must be in the primer layer. The cited reference fails to teach or suggest that the glass fibers be located in either (1) the primer layer or (2) both the primer layer and the top layer. Because this limitation is not taught by the cited reference, Applicant respectfully submits that the rejection has been overcome.

Claim Rejections - 35 U.S.C. §103

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama. The Examiner asserts that Matsuyama teaches the invention cited above with the exception of the glass particles being mixed into only the primer layer. The Examiner concludes that it would have been obvious to have the glass particles mixed only to the primer layer as a matter of design choice. The Examiner notes that Applicant has not disclosed that mixing glass particles only to the primer provides an advantage, is used for a particular purpose, or solves a stated problem.

Applicant respectfully disagrees with this rejection, because there is no suggestion to one skilled in the art to include the glass particles in the primer layer.

Applicant notes that Matsuyama teaches that glass fibers are mixed into the outer fluororesin coating to enhance wear resistance. There is no teaching or suggestion that the glass fibers do not need to be in the outer layer to provide this wear resistance, or any other benefit.

In the Office Action, the Examiner claims that

> [o]ne of ordinary skill in the art would have expected Applicant's invention to perform equally well with glass particles in the top layer as taught by Matsuyama or with the claimed glass particles being mixed only to the primer layer because glass particles placed in either the top layer only or the primer layer only perform the same function of providing good releasability. It is noted that in Table 3 of Applicant's specification at page 12, the use of a roll with glass particles mixed only into the primer layer does not provide an improvement over the embodiment of glass particles mixed into only the top layer.

Applicant respectfully disagrees with the above rejection. Applicant first notes that the Examiner is using Applicant's own disclosure to show that one skilled in the art would have known that particles in either layer perform the same function of providing good releasability. Applicant notes that the present disclosure is not prior art that is available to be used against the present invention.

Furthermore, Applicant asserts that the Examiner's reference to Table 3 of the specification actually helps Applicant's position, because as the Examiner notes in the present

specification, the use of glass particles in the primer layer alone provides the same benefit as having the glass particles mixed into only the outer layer. And as noted above, this would not have been expected based solely on Matsuyama without the use of the present application.

Therefore, Applicant traverses this rejection.

Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Yakushiji (JP 58017872 A).

The Examiner asserts that Matsuyama teaches the invention cited above with the exception of the glass particles being mixed into the primer layer. The Examiner asserts that Yakushiji teaches glass particles mixed into a primer layer 2. The Examiner concludes that it would have been obvious to have alternatively provided the invention of Matsuyama with glass particles mixed into the primer layer, in light of the teachings of Yakushiji, in order to reinforce the primer layer as suggested by Yakushiji at lines 7-8.

Applicant respectfully disagrees with this rejection and asserts that there is no suggestion contained in Yakushiji or Matsuyama to combine these cited references. Applicant notes that Yakushiji is directed to addressing the problems associated with preventing peeling of brittle paint layers, while the present invention is directed toward fixing rollers having a layer of fluororesin on the outside thereof. While both are directed to the generously broad category of coatings, there is no suggestion in the cited reference that science applicable to paint coatings would be applicable to the art of fluororesin-coated rollers. Therefore, there does not appear to be a suggestion for one skilled in the art at the time of the present invention to have used glass particles for a paint primer layer.

Applicant therefore traverses the rejection due to there being no suggestion to combine the references and no expectation of success if having done so.

Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Ream et al. (U.S. Patent No. 6,284,373). The Examiner notes that Ream et al. teaches a primer layer and top layer being arranged in up to 30 micrometers (col. 4, lines 24-34).

The Examiner asserts that it would have been obvious to have made the thickness of the primer layer and the top layer being arranged in up to 30 micrometers, in order to provide a layer having the desired thickness that is evenly applied to the roll surface.

Claim 8 is further rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Tsukida et al. (U.S. Patent No. 5,450,181) and Takahashi et al. (U.S. Patent No. 6,132,815). The Examiner notes that Tsukida et al. teaches a fluororesin layer having a thickness of 20 micrometers (col. 21, lines 26-27). Takahashi et al. teaches a primer layer having a thickness of 8 micrometers (col. 8, lines 47-48). The Examiner concludes that it would have been obvious to have provided the invention of Matsuyama with the appropriate primer layer and top layer thicknesses in order to provide a layer having the desired thickness that is evenly applied to the roll surface and has good releasability.

Applicant herein amends claim 1, and asserts that claim 1 is now clearly patentably distinct. Because claim 8 is dependent from claim 1 and necessarily includes at least its limitations, Applicant submits that claim 8 is also patentably distinct.

Claims 9-11 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Jinzai (U.S. Patent No. 5,572,275).

The Examiner asserts that Matsuyama teaches the invention cited above with the exception of a fluororesin overtop layer. Jinzai teaches in Fig. 2 a fixing roller 1 which has a fluororesin overtop layer 1a applied to the peripheral surface of a top layer 1a. Note that Jinzai also teaches a primer layer 1b and the top layer 1a is also a fluororesin layer (PFA). The

Examiner asserts that it would have been obvious to have provided the invention of Matsuyama with a fluororesin overtop layer applied to the peripheral surface of the top layer, in light of the teachings of Jinzai, in order to provide an anti-offset layer (as suggested by Jinzai at col. 4, line 18).

Claims 12, 13 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Jinzai as applied to claims 9, 10 and 14 above, and further in view of Ream et al. Claims 12, 13 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuyama in view of Jinzai as applied to claims 9, 10 and 14 respectively above, and further in view of Tsukida and Takahashi et al.

Dependent claims 9-15 do not appear to provide patentable distinctions over their independent claim 1. Therefore, if the rejection of the base independent claim 1 is overcome then this rejection will be overcome. We believe that the rejection of claim 1 can be overcome with appropriate amendment, as described above.

Applicant herein amends claim 1, and asserts that claim 1 is now clearly patentably distinct. Because claims 9-15 are dependent from claim 1 and necessarily include at least its limitations, Applicant submits that claims 9-15 are also patentably distinct.

In view of the aforementioned amendments and accompanying remarks, Applicant submits that that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicant respectfully petitions for an extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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